

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. APPLN. NO. 09/838,342  
ATTORNEY DOCKET NO. Q64164

**REMARKS**

Claims 1-21 have been examined on their merits.

Applicant herein amends the specification to correct errors with respect to the Figure numbers set forth in the specification. The Figure reference numbers now correctly correlate with the Figures. No new matter has been added. Entry of the amendments to the specification is respectfully requested.

Applicant herein amends claims 1, 11 and 21 to more clearly recite that the specification information received from each provider of a multi-component product is individualized.

Applicant herein editorially amends claim 18 to more clearly recite that the received user information is stored. The amendments to claim 8 do not narrow the literal scope of the claims, were not made for reasons of patentability and thus do not implicate an estoppel in the application of the doctrine of equivalents. Entry and consideration of the amendments to claims 1, 11, 18 and 21 is respectfully requested.

Claims 1-21 are all the claims presently pending in the application.

1. Claims 1-21 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hecksel *et al.* (U.S. Patent No. 6,151,707) in view of Japanese Patent Publication No. Heisei 10-301996 (hereinafter JP '996).<sup>1</sup> Applicant traverses the rejection of claims 1-21 for at least the reasons discussed below.

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<sup>1</sup> The May 6, 2004 Office Action lists Call as the patentee. However, Haruki Hiroshi *et al.* are the listed inventors of the subject matter described in JP'996. U.S. Patent No. 5,913,210 was issued to Call, and ... (footnote continued)

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The Patent Office acknowledges that Hecksel *et al.* fail to teach or suggest receiving specification information that specifies at least one data item required by a plurality of companies for user registration. *See* May 6, 2004 Non-Final Office Action, page 5. The Patent Office asserts that JP '996 allegedly overcomes the acknowledged deficiencies of Hecksel *et al.*

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).
- b) The proposed modification of the prior art must have had a reasonable expectation of success, as determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).
- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In*

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the February 18, 2004 Rule 114(c) Amendment has overcome the earlier claim rejections based on the combination of Hecksel *et al.* and Call.

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*re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless of whether the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; see also, *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

With respect to claim 1, the combination of Hecksel *et al.* and JP ‘996 fail to teach or suggest at least receiving individualized specification information from a plurality of companies, wherein the individualized specification information specifies at least one data item that is required for user registration for that particular company, extracting the specified data item for each individualized specification information from the user information stored in a database, and generating to-be-registered information required by each company for user registration based on its individualized specification information. For example, Figures 3a-3c of Hecksel *et al.* illustrate the gathering of information for user registration, but Figures 3a-3c (and their accompanying text) do not teach or suggest that such information gathering is performed on the basis of individualized specification information that is received from a software company

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terminal. Instead, Hecksel *et al.* disclose a registration program that gathers information about the user, as well as program statistics, and the registration program does not use individualized specification information received from a vendor terminal in the performance of its registration tasks. *See, e.g.*, col. 9, lines 38 to col. 11, line 55 of Hecksel *et al.* JP '996 does not teach or suggest the receiving of individualized specification information from a plurality of companies, wherein the individualized specification information specifies the data needed by each company for registering that company's portion of a multi-component product. Instead, JP '996 discloses, *inter alia*, a user registration tool (15) that provides user information to a master database (17) and a software provider registration tool (19) that accesses the master database. JP '996 fails to teach or suggest, however, that the software provider registration tool sends individualized specification information to the master database for each provider. Furthermore, the user registration tool does not send individualized specification information from providers to a registration information generating section. The combination of Hecksel *et al.* and JP '996 fails to teach or suggest a plurality of companies sending individualized specification information of an information generating section of a multi-component product, and that the information generating section responds with registration information containing data items requested by each company's individualized specification information. Both Hecksel *et al.* and JP '996 are deficient with respect to at least the sending of individualized specification information from a plurality of companies for the purposes of extracting registration information.<sup>2</sup> In sum, neither

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<sup>2</sup> Applicant reminds the Patent Office that characterization of certain claim limitations or parameters as obvious does not make the claimed invention, considered as a whole, obvious. It is incumbent upon ... (footnote continued)

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Hecksel *et al.* nor JP ‘996, either alone or in combination, discloses the receipt of individualized specification information and the generation of registration information based on the received individualized specification information. Furthermore, with respect to claim 10, the combination of Hecksel *et al.* and JP ‘996 fail to teach or suggest specification information concerning a product demanded by the user, one or more companies that can supply the product demanded by the user and information regarding the product demanded by the user is sent to a company extracted from the information generating section. Thus, Applicant submits that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Since neither Hecksel *et al.* nor JP ‘996 disclose the receipt of individualized specification information and the subsequent generation of registration information based on the received individualized specification information, Applicant submits that one of ordinary skill in the art would not be motivated to combine the two references. *In re Dembiczak* and *In re Zurko* require the Patent Office to provide particularized facts on the record as to why one of skill would be motivated to combine the two references. Without a motivation to combine, a rejection based on a *prima facie* case of obviousness is improper. *In re Rouffet*, 149 F.3d 1350, 1357

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the Examiner to establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). This burden can only be satisfied by an objective teaching in the prior art or by cogent reasoning that the knowledge is available to one of ordinary skill in the art. See *In re Lalu*, 747 F.2d 703 (Fed. Cir. 1984)). Furthermore, the Patent Office may not rely on Official Notice, or judicial notice or a mere statement of obviousness at the exact point where patentable novelty is argued, but must come forward with pertinent prior art. See *Ex parte Cady*, 148 U.S.P.Q. 162 (Bd. of App. 1965).

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(Fed. Cir. 1998)). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). The Patent Office must make specific factual findings with respect to the motivation to combine references. *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002). The only motivational analysis provided by the Patent Office is that the combination of Hecksel *et al.* and '996 would reduce the cost of user registration. This analysis does not disclose why one of skill in the art would be motivated to combine Hecksel *et al.* and JP '996, especially in light of both references' deficiencies. Thus, Applicant submits that the Examiner cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembicza*k and *In re Zurko*.

Based on the foregoing reasons, Applicant submits that the combination of Hecksel *et al.* and JP '996 fails to teach or suggest all of the claimed elements as arranged in claim 1, and therefore, clearly cannot render the present invention obvious as recited in claim 1. Thus, Applicant submits that claim 1 is allowable, and further submits that claims 2-10 are allowable as well, at least by virtue of their dependency from claim 1. Applicant respectfully requests that the Examiner withdraw the § 103(a) rejection of claims 1-10.

Independent claim 11 has similar recitations as independent claim 1, namely the receiving of individualized specification information and the generation of registration information based on the received individualized specification information. Furthermore, with respect to claim 20, the combination of Hecksel *et al.* and JP '996 fail to teach or suggest a method that uses specification information concerning a product demanded by the user, one or more companies that can supply the product demanded by the user and information regarding the

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product demanded by the user is sent to a company extracted from the information generating section. Applicant submits that claim 11 is allowable for at least the same reasons as discussed above with respect to claim 1, and further submits that claims 12-20 are allowable as well, at least by virtue of their dependency from claim 11. Applicant respectfully requests that the Examiner withdraw the § 103(a) rejection of claims 11-20.

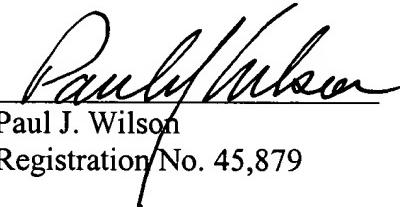
Independent claim 21 has similar recitations as independent claim 1, namely the receiving of individualized specification information and the generation of registration information based on the received individualized specification information. Applicant submits that claim 21 is allowable for at least the same reasons as discussed above with respect to claim 1, and respectfully requests that the Examiner withdraw the § 103(a) rejection of claim 21.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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Paul J. Wilson  
Registration No. 45,879

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

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